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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,481	09/05/2000	Mark C. Munro	47171-00125USC2	8168
30223	7590	06/16/2004	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			DANG, DUY M	
ART UNIT		PAPER NUMBER		
2621				15
DATE MAILED: 06/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/655,481	MUNRO ET AL.
	Examiner	Art Unit
	Duy M Dang	2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on \_\_\_\_\_.
- 2a)  This action is **FINAL**.                                    2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1 and 72-99 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1 and 72-99 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 05 September 2000 is/are: a)  accepted or b)  objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All    b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5,7,9,10.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's preliminary amendment file 9/5/00 and amendment filed 4/5/04 have been entered and made of record. Claims 1, and 72-99 are currently pending.
2. Applicant's remarks (see page 14 first two paragraphs filed 4/5/04) with regard to Restriction Requirement mailed on 3/11/04 have been fully considered and are persuasive. Thus the Restriction Requirement mailed on 3/11/04 has been withdrawn.
3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 72, 79, and 81-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following term lacks suitable antecedent basis: "the value" recited in claim 1 line 10, claim 72 line 10, claim 79 line 8, claim 81 line 10.

Claim 82 depends from claim 81 and is also rejected for the same reasons as above.

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 83-99 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 42-58 of prior U.S. Patent No. 6,351,551 (Referred as the patent '551 hereinafter). This is a double patenting rejection.

With regard to instant claim 83 as a representative claim, claim 42 of the patent '551 teaches a method of discriminating and counting currency bills comprising (see claim 42 lines 1-2):

receiving a stack of currency bills in an input receptacle of a currency evaluation device (see claim 42 lines 3-4);

transferring the bills, under the control of the evaluation device, one at a time from the input receptacle, past a sensor of a discriminating unit, to an output receptacle (see claim 42 lines 5-7);

determining, under control of the evaluation device, the denomination of each passing bill (see claim 42 lines 8-9);

incrementing, under the control of the evaluation device, a count corresponding to one of a plurality of denominations based on the determined denomination of each passing bill when the device determines the denomination of a bill (see claim 42 lines 10-14);

stopping, under the control of the evaluation device, the transferring when the device is unable to determine the denomination of a bill so that the bill whose denomination is not determined is located at a predetermined position within the output receptacle, the bill whose denomination is not determined being termed a no call bill (see claim 42 lines 15-21);

an operator of the evaluation device examining the no call bill (see claim 42 lines 22-23); and the operator either (see claim 42 line 23)

(a) depressing a key corresponding to the denomination of the no call bill when examining results in a determination that the bill is acceptable, whereby, under the control of the discrimination device, the corresponding count associated with the denomination of the no call bill is incremented and the transferring is continued (see claim 42 lines 24-30) ; or

(b) removing the no call bill without replacement when the examining does not result in a determination that the no call bill is acceptable and depressing a continuation key whereby, under the control of the bill evaluation device, the transferring is continued (see claim 42 lines 31-35).

It is noted that claims 84-99 of the instant invention are so identical to claims 43-58 of the patent '551. The examiner did express every features recited in the representative claim, instant claim 83 and pointed out all the corresponding features recited to the features recited in claim 42 of the patent '551. Since this is the "same invention" double patenting type rejection under 35 USC 101 and the claim language are so identical between the two applications, there appears no reasons to address all the features recited in the instant 82-99.

Regarding instant claim 84, see claim 43 of the patent '551.

Regarding instant claim 85, see claim 44 of the patent '551.

Regarding instant claim 86, see claim 45 of the patent '551.

Regarding instant claim 87, see claim 46 of the patent '551.

Regarding instant claim 88, see claim 47 of the patent '551.

Regarding instant claim 89, see claim 48 of the patent '551.

Regarding instant claim 90, see claim 49 of the patent '551.

Regarding instant claim 91, see claim 50 of the patent '551.

Regarding instant claim 92, see claim 51 of the patent '551.

Regarding instant claim 93, see claim 52 of the patent '551.

Regarding instant claim 94, see claim 53 of the patent '551.

Regarding instant claim 95, see claim 54 of the patent '551.

Regarding instant claim 96, see claim 55 of the patent '551.

Regarding instant claim 97, see claim 56 of the patent '551.

Regarding instant claim 98, see claim 57 of the patent '551.

Regarding instant claim 99, see claim 58 of the patent '551.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 5,790,0697 (Referred as the patent '697 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as follows:

With regard to instant claim 1, claim 5 of the patent '697 teaches a currency counting and discrimination device for receiving a stack of currency bills, rapidly counting and discriminating the bills in the stack, and then re-stacking the bills comprising (see claim 5 lines 1-4):

an input receptacle for receiving a stack of currency bills to be discriminated (see claim 5 lines 5-6);

a discriminating unit for discriminating the denomination of said currency bills (see claim 5 lines 7-8);

one or more output receptacles for receiving said currency bills after being discriminated by said discriminating unit (see claim 5 lines 9-11);

a transport mechanism for transporting said currency bills, one at a time, from said input receptacle past a sensor of said discriminating unit and to said one or more output receptacles (see claim 5 lines 12-15);

one or more counters keeping track of the value of bills discriminated (see claim 5 lines 16-17); and

value indicating means for an operator of said device to indicate the value of any bills whose denomination are not determined by said discriminating unit, said bills whose denomination are not determined by said discriminating unit being no call bills, said means appropriately effecting said one or more counters; and wherein the operation of said device is suspended when said discriminating unit is unable to identify the denomination of a bill (see claim 5 lines 18-23).

The difference between the instant claim 1 and claim 5 of the patent '697 is the extraneous feature recited in patent '697 claim 5 lines 24-26.

It would have been obvious to a person of ordinary skill in the art to exclude such a extraneous feature as evidenced by claim 1 of the patent '697 in order to simplify the system.

9. Claims 72-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6-7, 9, and 13-16 of U.S. Patent No. 6,351,551 (Referred as the patent '551 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as follows:

With to a representative claim 72, claim 15 of the patent '551 teaches a currency counting and discrimination device for receiving a stack of currency bills, rapidly counting and discriminating the bills in the stack, and then re-stacking the bills comprising (see claim 15 lines 1-4):

an input receptacle adapted to receive a stack of currency bills to be discriminated (see claim 15 lines 5-6);

a discriminating unit adapted to discriminate the denomination of the currency bills (see claim 15 lines 7-8);

an output receptacle adapted to receive the currency bills after being discriminated by the discriminating unit (see claim 15 lines 9-11); a

a transport mechanism adapted to transport the currency bills, one at a time, from the input receptacle past a sensor of the discriminating unit and to the one or more output receptacles (see claim 15 lines 12-15);

one or more counters adapted to keep track of the value of bills discriminated (see claim 15 lines 16-17);

a controller programmed to suspend the operation of the transport mechanism when the discriminating unit is unable to identify the denomination of a bill (see claim 15 lines 18-20); and

an operator interface capable of receiving input from an operator of the device, the interface enabling, upon suspension of the operation of the device, the operator to either (a) indicate the value of a bill whose denomination is not determined by the discriminating unit and restart the operation of the device or (b) restart the operation of the device without indicating the value of a bill whose denomination is not determined by the discriminating unit (see claim 21-29).

Smith discloses substantially the claimed invention as set forth in the discussion above for claim 72. Smith does not disclose expressly an output receptacle.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use one output receptacle. Applicant has not disclosed that using one output receptacle provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either more than one output receptacles taught by claim 15 of the patent '551 or a single output receptacle claimed because both one output receptacle or more than one output receptacle perform the same function of receiving the currency after being discriminated by the discriminating unit.

The advanced statements with regard claim 72 above are incorporated hereinafter.

Regarding instant claims 73-75, see claims 1-3 of the patent '551.

Regarding instant claims 76-77, see claims 6-7 of the patent '551.

Regarding instant claim 78, see claim 9 of the patent '551.

Regarding instant claims 79-80, see claims 13-14 of the patent '551.

Regarding claims 81-82, see claims 15-16 of the patent '551.

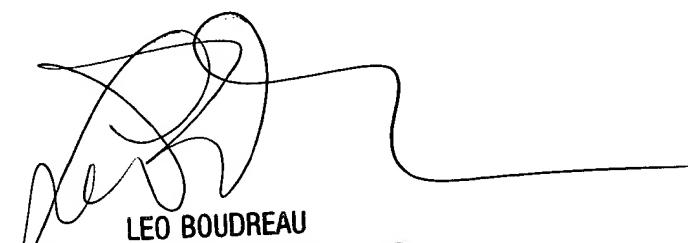
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M Dang whose telephone number is 703-305-1464. The examiner can normally be reached on Monday to Thursday from 6:30AM to 5:00PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMD

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6/9/04



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